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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,869	02/27/2004	Ben Nee Goon	TI-32154	7235
23494 7590 10/02/2007 TEXAS INSTRUMENTS INCORPORATED P O BOX 655474, M/S 3999 DALLAS, TX 75265			EXAMINER MOONEYHAM, JANICE A	
			ART UNIT 3629	PAPER NUMBER
			NOTIFICATION DATE 10/02/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@ti.com
uspto@dlemail.itg.ti.com

Office Action Summary

Application No.

10/788,869

Applicant(s)

GOON, BEN NEE

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-13, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-13 and 15-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response the applicant's communication filed on August 3, 2007, wherein:

Claims 1, 6-13 and 15-16 are currently pending;

Claims 2-5, 14 and 17-20 have been cancelled;

Claim 1 has been amended.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 3, 2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 recites the limitation "the tested device". There is insufficient antecedent basis for this limitation in the claim.
4. Claims 1 and 6-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 discloses a product being tested. Then the applicant refers to a tested device. Then applicant again refers to the product being shipped. Applicant may want to use either the term device or product, but using both in the same claim makes the claim language unclear.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anecki et al (US 2006/0010377) (hereinafter referred to Anecki).

Referring to Claim 15:

Anecki discloses a computer readable medium for carrying out one or more sequences of instructions for web-based process of a document, the instructions comprising:

providing a legal document database that is **operable** to store a plurality of documents and elements ([0044], Figure 1 (1070) Figure 2 (1130));

receiving at the database a request from the requester (Figure 2 (1100) [0048]);

sending a notification from the database to the plurality of responders (Figure 2 (1160, 1190) [0009]; and

transmitting data from the database to the requestor, whereby the requester **may** determine whether the request has been approved by at least one of the plurality of responders (Figure 2 (1170) (1192), [0007] [0046] [0051] [0053]).

Anecki does not explicitly disclose that the document is a waiver request.

However, Anecki discloses a method for network based document management environment wherein the term "document" is any instrument conveying information.

Thus, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the interactive method of automating the generation of legal documents among multiple requestors and requiring approval of various participants as disclosed in Anecki with the ability to make one of the documents a waiver request since one skilled in the art would recognized a waiver as simply being a legal document providing an express statement, which intentionally and voluntarily gives up something, such as rights, since in many business environments, large numbers of legally binding documents need to be generated, executed, and tracked by participants and many business need to route the documents through a number of different participants and a distributed system as disclosed in Anecki provides for the coordination and generation of the documents.

As for the language that "the request seeking a waiver of at least one of the specification elements from at least one of the plurality of responders" and the notification "seeking the requested waiver of the at least one specification element", the Examiner deems this language to non-functional descriptive data, not functionally related to the steps of the method. Non-functional descriptive data adds little, if

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anything, to the claimed acts and thus does not serve as a limitation on the claims to distinguish over the prior art. The providing a database step, the receiving a request at the database, the sending a notification, and the transmission of data from the database would be the same, no matter what language is in the request or the notification (See *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

As for the language that the database is *operable* to store data, the applicant is directed to MPEP section 2106 wherein it states that:

C. Review the Claims

The claims define the property rights provided by a patent, and thus require careful scrutiny. The goal of claim analysis is to identify the boundaries of the protection sought by the applicant and to understand how the claims relate to and define what the applicant has indicated is the invention. USPTO personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. See *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) ("[T]he name of the game is the claim.").

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter.

USPTO personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, regardless of whether the claimed invention is defined using means or step plus function language. The correlation step will ensure that USPTO personnel correctly interpret each claim limitation.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language

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that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

2111.04 "Adapted to," "Adapted for," "Wherein," and "Whereby" Clauses [R-3] - 2100 Patentability

2111.04 "Adapted to," "Adapted for," "Wherein," and "Whereby" Clauses [R-3]

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "'whereby' clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*

The Examiner interprets the term "operable" as being adapted for. Thus, when applicant claims that a database is operable to store requests and elements, then all that is required is a database fully capable of storing the

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requests. The Examiner asserts that the database in Anecki is fully capable of storing the claimed data.

As for applicant's limitation in claim 15 which reads "transmitting data from the waiver request database to the requestor, whereby the requestor *may* determine whether the waiver request has been approved", the Examiner asserts that the term "may" is not a positive recitation of a step. Applicant is directed to MPEP 2106 wherein it states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

As for the language in claim 16 which claims wherein the request is for the waiver of at least one test corresponding to the at least one of the specification elements and wherein the instructions are configured for:

notifying the requestor for additional information;
receiving additional information,
and notifying the plurality of responders about the information

The Examiner asserts the following:

The Examiner deems this language to non-functional descriptive data, not functionally related to the steps of the method. Non-functional descriptive data adds little, if anything, to the claimed acts and thus does not serve as a limitation on the claims to distinguish over the prior art. The providing a database step, the receiving a request at the database, the sending a notification, and the transmission of data from the database would be the same, no matter what language is in the request or the notification (See *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

6. Claims 1 and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anecki et al (US 2006/0010377) (hereinafter referred to Anecki) in view of McKay et al (US 6,418,551) (hereinafter referred to as McKay) and further in view of Dallas Semiconductor with a publication date of 5/30/02 (herein after referred to as Dallas).

Referring to Claim 1:

Anecki discloses a method for processing legal documents over a network connecting a requestor to a plurality of responders relative to a specification having a plurality of elements, method comprising:

providing a legal document database that stores a plurality of documents ([0044]; Figure 1 (1070); Figure 2 (1130));

receiving at the document request database a request from the requestor (Figure 2 (1100) [0048]);

sending a notification from the database to the plurality of responders (Figure 2 (1160, 1190) [0009]); and

transmitting data from the database to the requestor (Figure 2 (1170) (1192) [0007] [0051] [0053]).

Anecki does not disclose testing a product, initiating and transmitting a request requesting a waiver if a tested device fails an element of the specification, or shipping the device if the plurality of responders approve the document.

However, McKay discloses testing a product (invention relates to design, layout, testing and manufacture of microelectronic circuits, col. 1,, lines 13-16) and waiving one or more design rule violations when running design rule checking operations (col. 2, line 57 thru col. 3, line 28).

It would have been obvious to one of ordinary skill in the art to combine the legal document processing method of Anecki with the product testing and waiver method disclosed in McKay because each violation of a design rule is preferably treated initially as a "suspected" violation prior to comparing one or more waiver layout patters, wherein at the end of the comprehensive DRC operation, separate files may be generated to list occurrences that have been waived and those that have not been waived, wherein waiving one or more design rule violations may be advantageous in circumstances where a portion of a layout containing a known technical violation is also known to yield acceptable results.

Dallas discloses wherein appropriate people must approve of changes to controlled documents (page 8) and that shipping personnel shall prepare all shipping

documentation for review wherein no product shipment shall leave the warehouse until it passes inspection by quality control (page 22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into legal document processing method of Anecki the shipping control taught in Dallas because customers require quality and quality improves profitability.

Referring to Claims 6 and 8-9:

Anecki does not disclose receiving at least one response to the notification from the plurality of responders or receiving a second response from the plurality of responders wherein the response is approval of the request, rejection of the request, request for additional information or requesting a hold on the request.

However, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the document exchange disclosed in Anecki the ability to process multiple requests.

Moreover, the data in the response is non-functional descriptive data. When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. See *Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; see also *Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However,

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the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the substrate. The Examiner asserts that the data identifying the information in the responses adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data which does not explicitly alter or impact the steps is non-functional descriptive data. Except for the meaning to the human mind, the data identifying the information in the responses does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention.

Referring to Claim 7:

As for claim 7, the Examiner notes that the limitation states that if the at least one response is a request for additional information, notifying the requestor about the

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additional information, receiving additional information from the requestor, and notifying the plurality of responders about the additional information.

The Examiner directs the applicant to MPEP 2106 wherein it states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Referring to Claim 10:

McKay discloses generating a database entry corresponding to each request (col. 3, lines 11-28).

Referring to Claim 11:

Anecki discloses wherein the database is a distributed database comprising one or more database servers (Figure 1).

Referring to Claim 12:

Anecki discloses wherein sending the notification comprises sending one of an e-mail, instant text message, or prerecorded voice message ([0009], [0037], [0041-0043])

Referring to Claim 13:

Anecki discloses repeating the sending of the notification for a certain time period or until a certain number of response are received (Figure 2 [0009]).

Response to Arguments

Applicant's arguments with respect to claims 1, 6-13 and 15-16 have been considered but are moot in view of the new ground(s) of rejection. The arguments are directed to the newly amended claim limitations which the Examiner has addressed in the new grounds of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,115,546 discloses an apparatus and method for managing data obtained during the Design Rule Check and Layout versus Schematic verification procedures.


US 2005/0188336 discloses a system and method for waiving a verification check associated with a circuit design.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM


JANICE A. MOONEYHAM
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600